

Application No.: 10/633,726
Filing Date: August 4, 2003

REMARKS

Claim 10 has been amended to clarify the preamble and the pre-selecting limitation. Claim 12 has been amended to correct a typographical error. Claim 15 has been amended clarify that high intensity focused ultrasound energy is directed only to the uterine fibroid base. Support for this amendment may be found in the specification, for example, on page 13, lines 8-17, and Figures 9A and 9B. Claim 13 has been canceled without prejudice to pursuing it in a divisional, continuation, or continuation-in-part application. Claims 10-12 and 14-17 remain pending.

The Applicants have carefully considered all of the rejections cited in the Office Action, but respectfully submit that the claims are allowable for at least the following reasons.

Rejection under § 102

Claim 10 was rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,425,867 (Vaezy et al.). As discussed during the interview, the Applicants wish to remind the Examiner that a 37 C.F.R. § 1.131 declaration was filed on September 21, 2005 swearing behind the Vaezy et al. non-provisional filing date of September 17, 1999. As previously pointed out, the provisional application to which Vaezy et al. claims priority does not contain any disclosure relating to selecting tissue treatment sites for necrosing that will decrease the blood supply to a uterine fibroid. Accordingly, the Applicants respectfully submit that Claim 10 is not anticipated by Vaezy et al.

Rejections under § 103

Claims 11, 13, and 14 were rejected under 35 U.S.C. § 103(a) as being obvious over Vaezy et al. in view of U.S. Patent No. 5,601,526 (Chapelon et al.). Claim 13 has been canceled, rendering its rejection moot. Claim 14 recites determining a tissue treatment zone that causes a decrease in blood supply to a tumor. As discussed above, the provisional application to which Vaezy et al. claims priority does not contain any disclosure relating to decreasing blood supply to a tumor. Accordingly, the portion of Vaezy et al. appearing in the provisional application in combination with Chapelon et al. do not teach or suggest all limitations present in Claim 14. Thus, Applicants respectfully submit that Claim 14 is not obvious.

With respect to Claim 11, it recites causing pre-focal heating and necrosis of a substantial portion of tissue between the transducer and the transducer's focal point. Chapelon et al. directly teaches away from such a technique. *See* Chapelon et al., column 1, line 67 to column 2, line 7

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(“allowing a lesion in tissue to be treated which is *strictly limited to the focal point* of the treatment device … limiting or avoiding effects due to heat spreading around the focus point, with cavitation phenomena being *limited exclusively to the focal point or to the focal region*, and *without substantial cavitation phenomena being produced outside said focal point or region.*”) (emphasis added). Accordingly, the Applicants respectfully submit that Claim 11 (and Claim 14) are not obvious over the cited art.

Claims 15-17 were rejected under 35 U.S.C. § 103(a) as being obvious over Vaezy et al. in view of U.S. Patent No. 5,643,179 (Fujimoto). Claims 15-17 recite directing high intensity focused ultrasound energy only to a uterine fibroid base. Neither the provisional application to which Vaezy et al. claims priority nor Fugimoto teach selectively targeting the uterine fibroid base. Furthermore, Fujimoto teaches away from such selective application of ultrasound energy. *See* Fujimoto, column 4, lines 25-34 (“scanning the focal point 5 *thoroughly over the entire diseased portion 4*”) (emphasis added). Accordingly, the Applicants respectfully submit that Claims 15-17 are not obvious over the cited art.

No Disclaimers or Disavowals

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, the Applicants are not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. The Applicants reserve the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that the Applicants have made any disclaimers or disavowals of any subject matter supported by the present application.

CONCLUSION

In view of the foregoing, the Applicants respectfully request a timely issuance of a Notice of Allowance. If there are any remaining issues that could be resolved via a telephone call and/or Examiner’s amendment, the Examiner is invited to call the undersigned.

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Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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